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Total Number of Pages in This Submission: 11

Application Number	10/642,468
Filing Date	August 15, 2003
First Named Inventor	Zhuyin (Julie) LI et al.
Art Unit	1652
Examiner Name	MEAH, Mohammad Y.
Attorney Docket Number	USAV2002/0098 US NP

ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
  - ☐ Landscape Table on CD
- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☑ Other Enclosure(s) (please identify below): Claim Fee Sheet

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	sanofi-aventis		
Signature	George S. Jones		
Printed name	George S. JONES		
Date	January 05, 2006	Reg. No.	38508

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: (USPTO FAX NO. 571-273-8300 ; Total No. of Pages Transmitted: 11)

Signature	Delia Coughlin		
Typed or printed name	Delia Coughlin	Date	January 05, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Z. Li et al.

Application No.: 10/642,468

Filed: August 15, 2003

Title: METHOD FOR ASSAYING COMPOUNDS OR AGENTS FOR ABILITY TO DECREASE THE ACTIVITY OF MICROSOMAL PROSTAGLANDIN E SYNTHASE OR HEMATOPOIETIC PROSTAGLANDIN D SYNTHASE

Examiner:

Art Unit:

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Alexandria, VA 22313-1450

Transmitted herewith is an amendment in the above-identified application.

☐ No additional fee is required.

The fee has been calculated as shown below.

(1)	(2) CLAIMS REMAINING AFTER AMENDMENT*	(3)	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR** / ***	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	32	MINUS	28	4	50.00	200.00
INDEPENDENT CLAIMS	4	MINUS	4	0	200.00	
MULTI-DEPENDENT CLAIMS(S), Per Application (360.00)						0
			TOTAL AMENDMENT FEE FOR THIS AMENDMENT →			200.00

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.
** If the "Highest Number Previously Paid For" in Total Claims is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" in (Independent Claims is less than 3, write "3" in this space.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. 1.16 which may be required by this paper or credit any overpayment to Account No. 18-1982. Two duplicate copies of this paper are enclosed.

Respectfully submitted,

George S. Jones

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Docket No. USAV2002/0098 US NP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Z. Li et al.

Application No.: **10/642,468**

Filed: **August 15, 2003**

Title: **METHOD FOR ASSAYING COMPOUNDS OR AGENTS FOR ABILITY TO DECREASE THE ACTIVITY OF MICROSOMAL PROSTAGLANDIN E SYNTHASE OR HEMATOPOIETIC PROSTAGLANDIN D SYNTHASE**

Examiner: Meah, Mohammad

Art Unit: **1652**

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REPLY TO RESTRICTION REQUIREMENT

Mail Stop Amendment
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In response to the Office Action mailed December 5, 2005, the shortened period of response set at one-month, Applicants reply to the Restriction Requirement by electing the second Group II with traverse. The Office Action characterized Group II as drawn to screening compounds that decrease activity of PG synthase "comprising SEQ ID NO: 4." Applicants respectfully point out that this characterization of the claim scope is inaccurate and improper. The detection method detects the analyte (PGD_2 and/or PGE^2) independent of the specific sequence of the enzyme. Any process that changes the PG precursor substrate to the desired PG product is appropriate for the assay method. Notably, only claims 5, 22-26 and 28 recite SEQ ID NO: 4. Thus Applicants respectfully assert that an election of species is more proper than a Requirement for Restriction. Accordingly, to expedite prosecution, Applicants elect as a species SEQ ID NO: 4. Applicants further traverse the Restriction Requirement on the basis that the Office Action further mischaracterizes the invention, for example, at page 2, lines 13-18:

> Inventions in group II and I are unrelated. Inventions are unrelated if it can be shown that they are not capable of use together and they have different modes of operation, different functions, or different effects. In the instant case the different inventions, inventions of group I and group II are method steps involving two prostaglandin synthases (with distinct amino acid sequence with different structures and functions) and produce different outcomes.
> (citation omitted).

Clearly inventions in group II and I can be used together and thus are not unrelated. See for example, the specification, page 11, lines 14-21 where "fluorescence label" is discussed. The use of two or more of the various labels (or other selected labels not listed) allows the skilled artisan to monitor multiple compounds with different emission spectra. Thus in a single assay the skilled artisan is able to determine whether a compound or agent modulates activity for as many enzymes as enzymes and labels are present.

While specific synthases may produce specific PGs and the PGs may produce different or distinguishable outcomes, the present invention is not directed to those outcomes. Rather the present invention is directed to e.g., "evaluating the ability of compounds or agents to decrease or inhibit the activity of a prostaglandin synthase". Specification, page 8, lines 16-18. Consequently, the present invention e.g., allows identification of " a compound or agent that may have applications in treating pain, inflammation, fever, or a combination thereof in a subject." Specification, page 8, lines 4-5. Whether the invention is practiced using e.g., a PGD, a PGE synthase or a mixture of synthases, the outcome is the same, identification of candidates for use in mediating synthase activity and thereby modifying an inflammatory, pain or other PGD or PGE mediated response.

Thus the inventions of groups II and I do not relate to recognized divergent subject matter, cannot be said to have acquired a separate status in the art, and clearly cannot be said to be distinct. Accordingly, Applicants respectfully assert that restriction for examination purposes is improper. However, as stated above, Applicants do not traverse this action if interpreted as an election of species requirement and have elected Group II (2d) in this context.

To emphasize the independence of the invention from specific SEQ ID NOs Applicants provide an amended set of claims.

Amended claims begin on page 3.

Accompanying remarks begin on page 9.